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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,798

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EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3774

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,798	Applicant(s) TOWNSEND ET AL.	
	Examiner JAVIER G. BLANCO	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 3-6,9,10, 12,13,15,17,21-24,27,28,31,33,35 and 37-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,8,11,14,16,18-20,25,26,29,30,32,34 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s)

3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/29/2006; 3/28/2007; 3/14/2008; 5/8/2009; 10/21/2009; 11/4/2009; 2/17/2010; 3/15/2010.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of **prosthetic foot**: species L (embodied in Figure 51); **foot keel**: species A (embodied in Figures 5 and 8); and **calf shank**: species A (embodied in Figures 15 and 16) in the reply filed on January 25, 2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 3-6, 9, 12, 13, 15, 17, 21-24, 27, 31, 33, 35, and 37-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Claims 10 and 28 are drawn towards non-elected species embodied in Figure 52. Therefore claims 10 and 28 are also withdrawn from further consideration. Election was made **without** traverse in the reply filed on January 25, 2010.

Claim Objections

3. The claims are objected to because of the following informality: please substitute each instance of "the device" with --the **posterior calf** device--. Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2, 7, 8, 10, 11, 14, 16, 18-20, 25, 26, 28-30, 32, 34, and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. **7,374,578 B2**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 1, 2, 7, 8, 10, 11, 14, 16, 18-20, 25, 26, 28-30, 32, 34, and 36 of the application and claims 1-23 of U.S. Patent No. **7,374,578 B2** lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 1-23 of U.S. Patent No. **7,374,578 B2** is in effect a “species” of the “generic” invention of claims 1, 2, 7, 8, 10, 11, 14, 16, 18-20, 25, 26, 28-30, 32, 34, and 36. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1, 2, 7, 8, 10, 11, 14, 16, 18-20, 25, 26, 28-30, 32, 34, and 36 of the application are anticipated by claims 1-23 of U.S. Patent No. **7,374,578 B2**, it is not patentably distinct from claims 1-23 of U.S. Patent No. **7,374,578 B2**.

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6. Claims 1, 2, 7, 8, 10, 11, 14, 16, 18-20, 25, 26, 28-30, 32, 34, and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

- (i) Pending claims of copending Application No. **11/234,159**;
- (ii) Pending claims of copending Application No. **11/411,133**;
- (iii) Pending claims of copending Application No. **11/643,676**;
- (iv) Pending claims of copending Application No. **11/643,677**; and
- (v) Pending claims of copending Application No. **10/594,797**.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the above-indicated applications claim an ankle and a shank connected to a foot and comprising a resilient member having a lower end reversely curved (or in the form of a spiral). This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 7, 8, 11, 14, 16, 18-20, 25, 26, 29, 30, 32, 34, and 36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **E.C. Carter** (US 2,453,969; cited in Applicants' IDS).

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Referring to Figures 1-6, Carter discloses a prosthetic foot comprising:

- (i) A longitudinally extending foot keel (Figure 1: plate 22; Figure 4: member 42) having forefoot, midfoot, and hindfoot portions;
- (ii) A resilient, upstanding calf shank (Figure 1: a single spring 6/18, or all of springs 6/18 combined as a unit) having a lower end (spiral 6) connected to the foot keel and extending upwardly therefrom to a middle portion of the shank by way of an anterior facing convexly curved surface (Figure 1: front surface of spiral 6, or front surface of coil 5; Figure 4: front surface of spring 40) extending upwardly in a substantially curvilinear manner above the ankle joint area, the shank having an upper end (Figure 1, first interpretation: end 9 by itself; Figure 1, second interpretation: coil 5 + strut 9; Figure 1, third interpretation: coil 5 + strut 9 + cylinders 13; Figure 1, fourth interpretation: coil 5 + strut 9 + portion 1; Figure 4, first interpretation: upper end 39; Figure 4, second interpretation: upper end 39 + cylinders 33; Figure 4, third interpretation: upper end 39 + portion 31) *for connection* with a supporting structure on a person's leg stump; and
- (iii) A posterior calf device including an elongated member (Figure 1: curvilinear spring 26; Figure 1: a single curvilinear spring 6/18; Figure 4: curvilinear spring 53) extending between and connected (directly or indirectly) to the upper end of the shank and a lower portion of the prosthetic foot *to store energy during force loading of the prosthesis and return the stored energy during force unloading (e.g., controls anterior movement, and assists posterior movement) to increase the kinetic power generated for propulsive force by the prosthesis in gait* (see column 3, lines 5-14). The "at least one spring" is any of curvilinear springs 6/18.

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Regarding claim 8, claim 16, and claim 18, the elongated member is retained (directly or indirectly) at the radially inner end of the spiral by a “fastener arrangement” or “coupling element” (Figure 1: 21/24/25) joining the resilient member to the prosthesis.

With regards to statements of intended use and other functional statements (e.g., adapted to be affixed; so as to assist or replace; adapted to extend; adapted to prevent; to limit; limits; etc.), they do not impose any structural limitations on the claims distinguishable over the device of **E.C. Carter**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

9. Claims 1, 2, 7, 8, 11, 14, 16, 18-20, 25, 26, 29, 30, 32, 34, and 36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **GOEMED ORTHOPAEDIE SERVICE** (DE 299 20 434 U1; cited in Applicants’ IDS).

Referring to Figure 1, GOEMED discloses a prosthetic foot comprising:

(i) A longitudinally extending foot keel (foot spring 3) shaped *to approximate* the shape of the bottom of a foot (see Figure 1), and having forefoot, midfoot, and hindfoot portions;

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(ii) A resilient, upstanding calf shank (leaf spring 11 + 15/16) extending upwardly from the foot by way of an anterior facing convexly curved surface, the shank having an upper end (**first interpretation:** 15/16; **second interpretation:** end region/loop 18) *for connection* with a supporting structure on a person's leg stump, and a lower end connected to the foot keel which lower end is reversely curved in the form of a spiral; and

(iii) A posterior calf device including an elongated member (curvilinear spring 12) connected between the upper end of the calf shank and a lower portion of the prosthetic foot *to store energy during force loading of the prosthesis and return the stored energy during force unloading (e.g., controls anterior movement, and assists posterior movement) to increase the kinetic power generated for propulsive force by the prosthesis in gait.* The “at least one spring” is 22.

Regarding claim 8, claim 16, and claim 18, the “coupling element” or “fastening arrangement” is 25/26/27 + 22/23/24.

With regards to statements of intended use and other functional statements (e.g., adapted to be affixed; so as to assist or replace; adapted to extend; adapted to prevent; ; to limit; limits; etc.), they do not impose any structural limitations on the claims distinguishable over the device of **GOEMED ORTHOPAEDIE SERVICE**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of

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no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

10. Claims 1, 2, 7, 8, 11, 14, 16, 18-20, 25, 26, 29, 30, 32, 34, and 36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Pitkin** (US 5,376,139; cited in Applicants' IDS).

Referring to Figures 1-3, Pitkin discloses a prosthetic foot comprising:

(i) A longitudinally extending foot keel (3 + 9) having forefoot, midfoot, and hindfoot portions;

(ii) A resilient, upstanding calf shank (1) having a lower end (bottom half) connected to the foot keel and an upper end (upper half, which includes loop 6) to connect with a supporting structure on an amputee's leg, the upper end being *movable* longitudinally of the foot keel in response to force loading and unloading of the calf shank during use of the prosthetic foot. The "anterior facing convexly curved portion" is loop 6, and the "reversely curved lower end in the form of a spiral" is spiral formed by 7 + 2;

(iii) A posterior calf device including an elongated member (any of curvilinear springs 4) *to store energy during force loading of the prosthesis and return the stored energy during force unloading (e.g., controls anterior movement, and assists posterior movement) to increase the kinetic power generated for propulsive force by the prosthesis in gait.* The "coupling element" or "fastening arrangement" is the bottom surface of 2. The "at least one spring" is one of curvilinear springs 4. Notice none of claim 1 and 19 recite any structure for said "posterior calf device".

With regards to statements of intended use and other functional statements (e.g., adapted to be affixed; so as to assist or replace; adapted to extend; adapted to prevent; ; to limit; limits; etc.), they do not impose any structural limitations on the claims distinguishable over the device

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of **Pitkin**, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:00 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David Isabella can be reached on **(571)272-4749**. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Javier G. Blanco/

Examiner, Art Unit 3774

/David H Willse/

Primary Examiner, Art Unit 3738